

R E M A R K S

This paper is being filed in response to an Office Action dated January July 2, 2004. A Request for Continued Examination (RCE) and a request for a two (2) month extension of time are also being filed concurrently with this paper. Claims 1-49 are currently pending in this application. Claims 1-29 have been rejected, and claims 30-49 have been withdrawn from consideration.

Applicants also enclose herewith a Declaration of Marc J. Halperin ("the Halperin Decl.") and a Second Supplemental Information Disclosure Statement. The Halperin Decl. and the documents submitted with the IDS provide evidence of secondary considerations regarding unobviousness. Pursuant to MPEP Section 2141, applicants respectfully request reconsideration of the pending claims in view of these secondary considerations.

Applicants thank the examiner for withdrawal of the rejections under Section 112, second paragraph.

I. Claims 1-13 are patentable over the "Pizza Inversion" article by Appleton, because the examiner has not established a prima facie case of obviousness and the examiner's unsupported obviousness contention is rebutted by secondary considerations.

Claims 1-13 remain rejected under 35 U.S.C. § 103(a) as unpatentable over the article "Pizza Inversion" by Brad Appleton ("Appleton article"). The Examiner asserts that the Appleton article separately teaches (1) folding one half of a slice of pizza over the other half ("the Half Fold") and (2) folding the pointed end of a slice of pizza towards the crust ("the End Fold"). (Appleton article, p. 4.) Although acknowledging the absence of any teaching or suggestion in the Appleton article to combine the two folds, the Examiner nevertheless asserts that it would have been obvious for the skilled artisan to apply the combined folds to obtain a closed pocket and prevent dripping of toppings and sauce. (January 29, 2004 Office Action, p. 3.) In the July 2, 1004 office action at p. 3, the examiner reiterates this position by stating "one would be motivated to combine the folds to form a more closed pocket to prevent toppings and sauce from dripping out and also to reduce the size of the pizza slice which facilitates handling."

Applicants respectfully traverse this rejection for the following reasons, as discussed in more detail below: (i) the examiner has not established prima facie case of obviousness; (ii) the Halperin Declaration rebuts the examiner's unsupported obviousness contention; and (iii) the

failure of prior attempts in the fast food industry to solve the problem of “on the go” single servings of pizza rebuts the examiner’s unsupported obviousness contention.

- A. The examiner has not established a prima facie case of obviousness based only on the Appleton article, because it fails to teach or suggest applying the combination of the Half Fold and the End Fold to a slice of pizza that is at least partially baked.

Applicants respectfully reiterate that the examiner has not established a prima facie case of obviousness. Applicants, therefore, incorporate by reference their arguments and comments presented in their April 23, 2004 amendment and response relating to the prima facie case of obviousness using the Appleton article. The following points summarize the earlier arguments:

- (1) The Appleton article fails to teach or suggest the combination of the two folds, as the Examiner acknowledges.
- (2) The entire purpose of the Appleton article is to present a method to consume pizza slices quickly, while it is still hot, without burning a person’s mouth, and the proposed solution is inverting one slice of pizza on top of another slice. (See e.g., Appleton article, pp. 1 and 2.)
- (3) The Examiner’s reliance of the Half Fold and the End Fold is misplaced, because the Appleton article actually teaches away from the presently claimed method. For example, The Appleton article teaches away from using the end fold because “You don’t get full slice coverage this way.” (Appleton article, p. 4, under the paragraph titled “2.0 Singleton Slice”.)
- (4) The Appleton article was published as early as 1995 and is still currently available on the internet. However, even after nine years of availability of this article on the internet (<http://www.cmcrossroads.com/bradapp/docs>), no one has suggested combining the End Fold and the Half Fold to a slice of pizza, as the Examiner asserts.

Without any motivation or desirability to combine the separately disclosed Half Fold and the End Fold in the Appleton article, applicants submit that the Examiner is using impermissible hindsight vision/reconstruction afforded by the claimed invention. The fact that aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. See e.g., MPEP 2143.01, especially the subsection title “Fact that the Claimed Invention is within the Capabilities of One of Ordinary Skill in the Art is Not Sufficient by Itself to Establish Prima Facie Obviousness.” Applicants, therefore, respectfully request withdrawal of this Section 103(a) rejection of claims 1-13.

B. The Halperin Declaration rebuts the examiner's unsupported contention that the combination of the two folds would have been obvious.

Applicants enclose herewith a Declaration of Mark J. Halperin ("Halperin Decl."). Mr. Halperin is an expert in the culinary arts in view of his impressive formal credentials, training, and experience. After obtaining an undergraduate from Reed College and a graduate degree from Boston University, Mr. Halperin was formally trained as a chef at École de Cuisine La Varenne in Paris, where he was awarded a Grand Diplôme d'Etudes Culinaires in 1979. (Halperin Decl., ¶ 3.) Mr. Halperin's practical experience as a professional chef and instructor is equally impressive. (See Halperin Decl. ¶ 4.) In each of his professional positions, Mr. Halperin had considerable experience baking and teaching others to bake foods involving dough. (*Id.*) Furthermore, Mr. Halperin also has significant additional experience in the baking of dough, as a consultant for the Croissant Show (New York, New York) and for Bon Appétit Bakeries (Denver, Colorado,). (*Id.*)

Since 1992, Mr. Halperin has been the Culinary Director at the Center for Culinary Development ("the Center") in San Francisco, California, a privately-owned consulting business. Mr. Halperin co-founded the Center and is currently a principal. (Halperin Decl., ¶ 2.) As Culinary Director, Mr. Halperin relies on his formal training and experience to provide consulting services in restaurant concept development, menu development, and new food and beverage product development for the retail consumer market as well as for restaurant and food service environments. (*Id.*) Mr. Halperin's has helped develop packaged foods, including pizza, as well as menu items for "fast food" restaurants. (*Id.*) Several of these products have been successfully commercialized on a national scale. (*Id.*)

As part of his work at the Center, Mr. Halperin also keeps informed of new trends, techniques and developments in the culinary arts by actively participating in professional groups and publications. (Halperin Decl., ¶ 5.) Of the new trends, Mr. Halperin has been particularly interested in the developing market for food "on the go" rather than at a table. (Halperin Decl., ¶ 6.) Mr. Halperin writes for two leading publications in the food industry, *QSR Magazine* (for the quick serve restaurant industry) and *Food Processing/Food Creation* (for the manufacturing industry). (Halperin Decl., ¶ 5.) Furthermore, Mr. Halperin manages the Center's Chef's Council, which consults with approximately eighty prominent chefs from across the United

States to study trends in the food industry. (*Id.*) Mr. Halperin is also a member or has been a former member of various prestigious culinary organizations. (*See* Halperin Decl., ¶ 5.)

With all of his formal training, experience, and knowledge of new trends in the culinary arts, Mr. Halperin opines that the combination of the two folds for a slice of pizza (that is at least partially baked) is new and innovative. (Halperin Decl., ¶ 8.) To Mr. Halperin, this method of folding pizza provides an elegant way to meet the need for “on the go” pizza while preserving the benefits of the traditional pizza slice. (*Id.*) The combination of the two folds was new and not obvious to Mr. Halperin, because he “did not expect the combination of the two folds to produce a satisfactory result.” (Halperin Decl. ¶ 9.)

Furthermore, Mr. Halperin is not aware of anyone utilizing the combination of the folds and, more importantly, is not aware of any successful attempts in the art to configure a traditionally backed pizza so that it can be eaten while not seated at a table without spillage of the cheese, sauce and toppings. (*Id.*) Mr. Halperin, therefore, concludes that the combination of the two folds has a significant potential to be the basis of a successful entrant in the “on the go” markets for pizza. (*Id.*) In fact, Mr. Halperin was so impressed by the claimed method of folding pizza that he favorably referenced the folding method in an October 2003 article titled “Humble inspirations, impressive destinations” for *Food Processing Magazine*. (Halperin Decl., ¶¶ 11 and 12, and Exhibit B, at p. 2, last paragraph.)

In view of these opinions for an expert in the culinary arts, applicants respectfully submit that they have successfully rebutted the examiner’s unsupported contention that the combination of the two folds would have been obvious. Applicants, therefore, respectfully request withdrawal of this Section 103(a) rejection of claims 1-13.

C. The failure of prior attempts in the fast food industry to provide “on the go” single servings of pizza further rebuts the examiner’s unsupported contention that the combination of the two folds would have been obvious

Concurrently submitted herewith in an Information Disclosure Statement are two articles that provide objective evidence of the fast food industry’s failure to meet the significant unfulfilled need for “on the go” single servings of pizza. The first article discusses how McDonald’s failed to successfully market pizza. McDonald’s recognized the need for “on the go” single servings of pizza, but was unable to meet this need. (*See* pp. 1 and 2 of Upbin, “Beyond Burgers,” *Forbes Magazine*, November 1, 1999.) In fact, McDonald’s tried for years to

sell McPizza without success, because “[c]ustomers didn’t want to wait ten minutes for a pizza when they could get a burger in 60 seconds.” (See first full paragraph, p. 4 of “Beyond Burgers.”) Furthermore, the pizzas did not fit through the drive-through windows in most stores. (*Id.*) In contrast, the method of claims 1-13 of the present application solves both of these problems, because (1) the pizza slice is at least partially baked (or completely baked) and (2) the combination of the two folds significantly decreases the size of the pizza slice.

The second article generally discusses how the fast food giants have recognized the need for new products in the “on the go” market. (See Horovitz, “What’s next: Fast-food giants hung for new products to tempt consumers,” USA Today, July 3, 2002, p. A01.) Specifically, this article discusses how Taco Bell failed to successfully commercialize “a pizza slice with gloppy Mexican toppings,” because “even teenage boys didn’t like the mess.” (See, p. 2, fourth full paragraph of “What’s next: Fast food giants”) In contrast, the method of claims 1-13 elegantly provide a way to encapsulate the messy toppings.

Both of these articles clearly show that both McDonald’s and Taco Bell recognized the commercial potential to provide “on the go” single servings of pizza. However, both of these large corporations with all of their culinary expertise failed to even contemplate the combination of the two folds, as recited in claims 1-13. Applicants, therefore, submit that these articles provide objective proof to rebut the examiner’s unsupported contention that the combination of the two folds would have been obvious. Withdrawal of this Section 103(a) rejection of claims 1-13 is respectfully requested.

II. Claims 14-29 are patentable over the Appleton article in view of the “Cooking A to Z” cookbook, because the examiner has not established a prima facie case of obviousness and the examiner’s unsupported obviousness contention is rebutted by the Halperin Declaration.

Claims 14-29 have been rejected under 35 U.S.C. § 103(a) as unpatentable over the Appleton article in view of p. 447 of the cookbook titled “Cooking A to Z” (“the Cookbook”). The Examiner points to the Appleton article for separately teaching (1) folding one half of a slice of pizza over the other half and (2) folding the pointed end of a slice of pizza towards the crust. (Appleton article, p. 4.) The Examiner points to page 447 of the Cookbook as showing a pizza slice having one end substantially free of toppings. Although acknowledging the absence of any teaching or suggestion by the Appleton article to combine to two folds, e.g., folding the end

portion and then folding one half over the other half, the Examiner asserts that it would have been obvious for the skilled artisan to apply the combined folds to obtain a closed pocket and prevent dripping of toppings and sauce. The Examiner further asserts that it would have been obvious to make a pizza without any toppings at one end as purportedly shown in p. 447 of the Cookbook, because pizza is a very versatile food product.

Applicants respectfully traverse this rejection for the following reasons, as discussed in more detail below: (i) the examiner has not established prima facie case of obviousness; and (ii) the Halperin Declaration rebuts the examiner's unsupported obviousness contention.

A. The examiner has not established a prima facie case of obviousness based only on Appleton article and the Cookbook, because the combination fails to teach or suggest applying the combination of the Half Fold and the End Fold to a slice of pizza having an end portion that is substantially free of toppings.

Applicants respectfully reiterate that the examiner has not established a prima facie case of obviousness. Applicants incorporate by reference herein their arguments presented above in relation to the deficiencies of the Appleton article. Applicants also incorporate by reference their arguments and comments presented in their April 23, 2004 amendment and response in regard to the prima facie case of obviousness using the Appleton article and the Cookbook. The following points summarize the earlier arguments:

- (1) Page 447 of the Cookbook does not even address, much less resolve, the deficiencies in the Appleton article;
- (2) Page 447 of the Cookbook seems to show a whole pizza with at least one topping, i.e., cheese, throughout the entire surface of the pizza. The slice of the pizza on p. 447 of the Cookbook, therefore, is not substantially free of toppings. (*See e.g.*, p. 6, lines 8-12 of the Applicants' specification, which includes cheese as a topping.)

Furthermore, a close inspection of the pizza shown at p. 447 of the Cookbook shows a vegetable topping in the center of the pizza. Accordingly, a slice of the pizza would have some of the vegetable topping on the end portion. Applicants, therefore, respectfully submit that the examiner's has not established a prima facie case of obviousness in the combination of the Appleton article (which provides no teach or suggestion of an end portion substantially free of toppings) and p. 447 of the Cookbook (which shows a topping on the end portion). Withdrawal of this rejection of claims 14-29 is respectfully requested.

B. The Halperin Declaration rebuts the examiner's unsupported contention that it would have been obvious to omit the cheese from one area of a pizza.

In the July 2nd Office Action, the examiner asserts without support the following:

While the pizza has cheese throughout the surface, the cookbook does show that the other toppings are limited to [a] certain area. What the cookbook suggest[s] is the versatility in making pizza. For example, it would have been obvious to omit the cheese in one area if one wants to reduce the fat content and calorie of the pizza.

(July 2, 2004 Office Action, p. 3.) In response, applicants respectfully invite the examiner's attention to paragraph 10 of the Halperin Declaration. As discussed above, Mr. Halperin is an expert in the culinary arts. Despite his formal training, experience, and knowledge of new trends in the culinary arts, Mr. Halperin states that it was not obvious to him to create a pizza with portions free of cheese and topping if cheese and toppings are elsewhere on the pizza. (Halperin Decl., ¶ 10.) In fact, Mr. Halperin opines that the consumer would not accept a pizza with cheese and toppings missing from a significant area, absent folding the pizza slice according to the present invention. (*Id.*) Although pizza can be configured to have different combinations of toppings in different sections, Mr. Halperin confirms that such pizzas would have the same toppings consistently throughout any particular section. (*Id.*)

In view of these opinions for an expert in the culinary arts, applicants respectfully submit they have successfully rebutted the examiner's unsupported contention that it would have been obvious to omit cheese and toppings in one area of a pizza slice. Applicants, therefore, respectfully request withdrawal of this Section 103(a) rejection of claims 14-29.

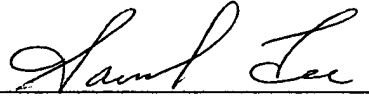
Conclusion

In view of the remarks provided above, applicants submit that the present application is in condition for allowance. Reconsideration and allowance is respectfully requested.

Respectfully submitted,

DERGOSITS & NOAH LLP

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By: 
Samuel S. Lee
Reg. No. 41,938

Enclosures.

Dergosits & Noah LLP
Four Embarcadero Center, Suite 1450
San Francisco, CA 94111
Tel: (415) 705-6377
Fax: (415) 705-6383